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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,489	10/07/2003	Mie Yoshino	243661US2CONT 4038	
	7590 05/21/2004		EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET			BRAUN, FRED L	
	A, VA 22314		ART UNIT	PAPER NUMBER
• •			2852	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application N .	Applicant(s)	Applicant(s)	
Office Action Comme	10/679,489	YOSHINO, MIE		
Office Action Summary	Examiner	Art Unit	· · · ·	
	Fred L. Braun	2852		
3) Since this application is in condition for allow closed in accordance with the practice under	PLY IS SET TO EXPIRE 3 N.  1.136(a). In no event, however, may a reply within the statutory minimum of thiod will apply and will expire SIX (6) MOI tute, cause the application to become A illing date of this communication, even if October 2003. his action is non-final.	vith the correspondence additional MONTH(S) FROM  reply be timely filed  rty (30) days will be considered timely. NTHS from the mailing date of this com BANDONED (35 U.S.C. § 133). If timely filed, may reduce any	munication.	
Disposition of Claims				
4) Claim(s) 1-15 is/are pending in the application 4a) Of the above claim(s) is/are withdred 5) Claim(s) is/are allowed. 6) Claim(s) 1-15 is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) is/are objected to. 8) Claim(s) is/are objected to restriction and constant and subject to restriction and constant and constant are subject to restriction and constant and constant are subject to restriction and constant are subject to by the Examination of the specification is objected to by the Examination of the specification is objected to by the specification of the specification is objected to by the specification of the specification is objected to by the specification of the spe	rawn from consideration.  I/or election requirement.  I/or election requirement.  I/or election requirement.  I/or election requirement.  I/or election required to objected to ne drawing(s) be held in abeyar ection is required if the drawing Examiner. Note the attached on priority under 35 U.S.C. §	nce. See 37 CFR 1.85(a). (s) is objected to. See 37 CFR d Office Action or form PTO	1.121(d). -152.	
Certified copies of the priority documents.  Copies of the certified copies of the priority documents.  Copies of the certified copies of the priority documents.  * See the attached detailed Office action for a list.  * See the attached detailed Office action for a list.  Attachment(s)  Notice of References Cited (PTO-892)  Notice of Draftsperson's Patent Drawing Review (PTO-948)	iority documents have been au (PCT Rule 17.2(a)). st of the certified copies not  4)   Interview S  Paper No(s	received in this National Stareceived.  Summary (PTO-413)  S)/Mail Date		
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08 Paper No(s)/Mail Date 10/07/03.		nformal Patent Application (PTO-15	52)	

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1. Claims 1, 2, 5-7 and 11-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are considered to fail to particularly point out and distinctly claim the invention, as required by the statutes, because the claimed recitation that "said roller portion has a volume resistively ranging from 0 ohms. cm to 10<sup>7</sup> ohms.cm" appearing on lines 14 and 15 of base claims 1 and 11, respectively; lines 16 and 17 of base claim 5; and lines 17 and 18 of base claim 13, respectively, includes a situation where the volume resistivity of the developing roller is 0 ohms. cm which means that it is has no volume resistivity at all thereby rendering said base claims and any claims dependent thereon indefinite.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In*

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re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970), and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- Claims 1-15, respectively, insofar as being definite, are rejected under the 5. judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, respectively, of U.S. Patent No. 6,636,716 to Yoshino. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the subject application, noted supra, are essentially verbatim the claims of U.S. Patent No. 6,636,716 to Yoshino except for the fact that base claims 1, 5, 11 and 13, respectively, add the recitation or limitation that the roller portion has a surface potential substantially equal to a bias for development while base claims 3 and 8, respectively, of U.S Patent No. 6,636,716 to Yoshino further recite that the roller portion has a ten-point mean surface roughness so as to reduce irregularities on a surface of the development liquid on the roller portion. Accordingly, it is submitted that the claims of the subject application are not patentably distinct from the subject matter being claimed in the commonly owned patent to Yoshino (6,636,716) and that issuance of a second patent would provide an unjustified extension of the term of the right to exclude granted by a patent. See Eli Lilly & Co. v Barr Labs, Inc., 251 F.3d 955, 58 USPQ 2d 1865 (Fed. Cir. 2001).
- 6. Claims 3 and 8 are further rejected under 35 U.S.C. 102(b) as being anticipated by lino et al ('148).

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It is submitted that the patent to Iino et al ('148) fully discloses the developing unit and/or the image forming apparatus recited in claims 3 and 8, respectively. More specifically, element 202 (Fig. 3) of Iino et al ('148) is the liquid developing roller which contacts the latent image carrier 1 (Fig. 3) (column 6, lines 60-63) while carrying a developing liquid consisting of a carrier liquid and a developing substance thereon (column 4, lines 33-38) for developing the latent image formed on said image carrier by depositing developing liquid on said latent image wherein said roller portion or outer surface of said developing roller has a ten-point mean surface roughness of 3 µm or less (column 9, lines 28 and 29; and column 14, lines 45-52 of Iino et al ('148).

7. Claim 10 is further rejected under 35 U.S.C. 103(a) as being unpatentable over lino et al ('148) as applied to claims 3 and 8 above, and further in view of Hosoya et al.

The patent to Hosoya et al (column 10, lines 14-16 and 40-55, respectively) suggests to one having ordinary skill in the art that the use of an amorphous silicon series photosensitive body is desirable because it exhibits excellent mechanical durability.

Therefore, to use a photosensitive body or image carrier in the liquid developer unit or device of Iino et al ('148) that is formed of amorphous silicon (a-Si) so that it exhibits excellent mechanical durability, as suggested by Hosoya et al, would be an obvious modification of the prior art to one having ordinary skill in the art at the time applicant's invention was made.

8. Any inquiry concerning this communication should be directed to Fred L Braun at telephone number (571) 272-2132.

Fred & Brown
FRED L BRAUN
PRIMARY EXAMINER
ART UNIT 2852